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ODS-18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Connie T. Marshall et al.  
Application No. : 09/729,484 Confirmation No. : 5978  
Filed : December 4, 2000  
For : SYSTEMS AND METHODS FOR INTERACTIVE  
WAGERING  
Group Art Unit : 3713  
Examiner : Binh-An D. Nguyen

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Sir:

Appellants are filing this Appeal Brief in support of the February 16, 2006 Notice of Appeal from the rejection of claims 4, 8, 14, and 18 in the final Office Action dated October 17, 2005.

Appellants hereby petition for a one-month extension of time under 37 C.F.R. § 1.136(a) for filing this Appeal Brief. The March 30, 2006 Notice of Panel Decision from Pre-Appeal Brief Review set a new one-month period for reply. With the extension, this Appeal Brief is due on or before May 30, 2006.

The Director is hereby authorized to charge \$620.00 to Deposit Account No. 06-1075 (Order No. 003043-0018) in payment

of the filing fee required under 37 C.F.R. § 41.20(b)(2) and the extension fee required under 37 C.F.R. § 1.17(a)(1). The Director is also hereby authorized to charge any additional fees that may be due in connection with this Appeal Brief, or credit any overpayment of the same, to Deposit Account No. 06-1075 (Order No. 003043-0018). A separate Authorization to Charge Deposit Account is enclosed for these purposes (in duplicate).

In view of the arguments and authorities set forth below, the Board should find the rejection of claims 4, 8, 14, and 18 to be in error, and the Board should reverse the rejection.

This Brief has the following appendices:

Claims Appendix

Appendix A: Copy of claims 4, 8, 14, and 18 involved in this appeal;

Evidence Appendices

Appendix B: Copy of the final Office Action dated October 17, 2005;

Appendix C: Copy of Brenner et al. U.S. Patent No. 6,004,211 (hereinafter "Brenner").

I. Identification Of Real Party In Interest

Appellants respectfully advise the Board that the real party in interest in the above-identified patent application is ODS Properties, Inc., a corporation organized and existing under the laws of the State of Delaware, and having an office and place of business at 6701 Center Drive West, Los Angeles, CA 90045, which is the assignee of this application. A copy of the recorded assignment document may be seen at Reel 011343, Frames 0093-0117.

II. Related Appeals And Interferences

Pursuant to 37 C.F.R. § 41.37(c)(ii), appellants respectfully advise the Board that there are no other appeals, interferences, or judicial proceedings known to them, their legal representative, or their assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of Claims

Claims 1-20 are pending in this application. Of these claims, claims 1-3, 5-7, 9-13, 15-17, 19, and 20 are withdrawn from consideration. Claims 4, 8, 14, and 18 stand finally rejected under 35 U.S.C. § 102(e) and are on appeal.

#### IV. Status Of Amendments

Appellants have not submitted any amendment pursuant to 37 C.F.R. § 1.116 or in reply to the Examiner's October 17, 2005 final Office Action (hereinafter "Office Action"), from which this Appeal is being sought.

#### V. Summary Of Claimed Subject Matter

Appellants' independent claims 4 and 14 are generally directed toward a method and system for providing a user interface for interactive wagering. A user is provided with an opportunity to create a default wager with at least one default setting. Default selections are displayed for a new wager based on the default wager, and the user is provided with an opportunity to change selections for the new wager from at least one of the default selections to another selection. The user is then provided with an opportunity to place the new wager.

#### VI. Ground Of Rejection To Be Reviewed On Appeal

The ground of rejection to be reviewed on appeal is the rejection of claims 4, 8, 14, and 18 under 35 U.S.C. § 102(e) as being anticipated by Brenner.

#### VII. Argument

##### A. The Rejection of Independent Claims 4 and 14

In the Office Action, the Examiner rejected independent claims 4 and 14 under 35 U.S.C. § 102(e) as being

anticipated by Brenner. Appellants respectfully traverse the rejection and submit that independent claims 4 and 14 patentably improve upon the teachings of Brenner. Appellants request that the rejection be overturned for at least the reasons set forth below.

1. Appellants' Claimed Invention Patentably Improves Upon Brenner by Providing a User an Opportunity to Change Default Selections

Generally speaking, Brenner refers to systems and methods for interactive off-track wagering. Brenner includes a "duplicate a wager" option that allows an existing wager to be copied and presented on the next available wager line. (See Brenner, col. 12, lines 45-50). After a wager has been duplicated, a user of Brenner's system may delete the wager, duplicate the wager again, or send the wager to a totalisator. (See Brenner, FIG. 17).

In the Office Action's "Response to Arguments" section, the Examiner states that Brenner shows an interactive wagering system "that enables the player to create a default setting type . . . that could be reused such as duplicating a wager or delet[ing] an undesired wager." (Office Action, page 4). The Examiner also states that Brenner further provides the user an opportunity to place a new wager either by duplicating the already created wager or creating another new

wager. The Examiner then concludes, therefore, that Brenner "fully anticipates the claimed limitations of claims 4 and 14."

Id.

Appellants' respectfully disagree. It is well-established that for a reference to anticipate a claim "each and every element as set forth in the claim" must be found in the reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Brenner shows a wager menu (i.e. menus 256 and 262 of FIGS. 16 and 17) summarizing all the wagers in the wager queue. Each wager is listed on a separate wager line. Depending on the state of the queue, various wager options are presented to the user. (See Brenner, FIG. 17 and column 12, lines 27-63). However, at no time may a user of Brenner's system "change selections for the new wager from at least one of the default selections to another selection," as required by appellants' independent claims 4 and 14.

When a user of Brenner's system selects the "duplicate a wager" button, a copy of the wager to be duplicated appears on the next available wager line. (See Brenner, column 12, lines 45-50). This new wager is identical to the copied wager, and the duplicated wager's selections cannot be edited or changed in any way. Rather, the only options available in Brenner's interface after a wager has been duplicated are to: 1) duplicate

the duplicated wager again, 2) delete the duplicated wager, or 3) send the duplicated wager to a totalisator. (See FIG. 17 and Brenner, col. 12, lines 45-50). Therefore, Brenner's "duplicate a wager" function does not provide the user with an opportunity to change selections for the new wager from at least one of the default selections to another selection, as required by appellants' independent claims 4 and 14.

A user may also delete a wager by selecting the "delete a wager" button. After selecting the "delete a wager" button, the wager to be deleted is removed from the wager line. The user may then create a new wager, delete another wager, duplicate a wager, or send the wagers in the queue to a totalisator. Id. However, as described above, at no time can a user change selections for a new wager from the default selections to another selection. Even if a new wager is created after deleting or duplicating an existing wager, the user must proceed through the wager creation steps anew. (See Brenner, column 12, lines 27-38). Selections from a previous wager are not reused for newly created wagers. Therefore, Brenner's "delete a wager" function does not provide the user with an opportunity to change selections for a new wager from at least one of the default selections to another selection, as required by appellants' independent claims 4 and 14.



Using appellants' claimed invention, a user may create a default wager (e.g., a \$5 exacta wager at Pimlico). Then, at some later time, the user may create a new wager. The new wager is displayed with default selections based on the default wager. The user is also given the opportunity to change selections for the new wager from the at least one default selection to a another selection. For example, the user may increase the bet amount from \$5 to \$6, change the bet type, or change the track. The user is then provided with an opportunity to place the new wager. This process facilitates the entry of commonly-used wager information into the interactive wagering system.

In contrast to appellants' invention, Brenner's system shows, among other things, the ability to create a new wager and duplicate the new wager in the same wager session. There is no opportunity, however, to change a default selection of a new or duplicated wager to another selection. The user may create another new wager, but this new wager is not based on any default settings. (See Brenner col. 12, lines 27-63 and FIG. 17).

Accordingly, because appellants' claimed invention patentably improves upon Brenner, appellants respectfully submit that the Examiner erred in rejecting independent claims 4 and 14. Appellants also submit that the Examiner erred in rejecting dependent claims 8 and 18, which contain all the limitations of

independent claims 4 and 14, respectively, for at least the same reasons. Accordingly, the rejection should be reversed and independent claims 4, 8, 14, and 18 should therefore be allowed.

#### VIII. Conclusion

For the reasons set forth above, appellants respectfully submit that claims 4, 8, 14, and 18 are in condition for allowance. The Examiner's rejection of these claims should be reversed.

Respectfully submitted,



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CLAIMS APPENDIX A  
CLAIMS 4, 8, 14, AND 18 ON APPEAL

1 - 3. (withdrawn)

4. (previously presented) A method of providing a user interface for interactive wagering, comprising:

providing a user with an opportunity to create a default wager, wherein the default wager includes at least one default setting;

displaying default selections for a new wager based on the default wager, wherein the new wager requires selection of at least a track, a race, a bet type, a bet amount and a horse;

providing the user with an opportunity to change selections for the new wager from at least one of the default selections to another selection; and

providing the user with an opportunity to place the new wager.

5 - 7. (withdrawn)

8. (previously presented) The method of claim 4, wherein the at least one default setting of the default wager is a previously selected track.

9 - 13. (withdrawn)

14. (previously presented) A system of providing a user interface for interactive wagering, comprising:  
a user input device that accepts user inputs; and  
control circuitry that provides a user with an opportunity to create a default wager as one of the user inputs, wherein the default wager includes at least one default setting, that displays default selections for a new wager based on the default wager, wherein the new wager requires selection of at least a track, a race, a bet type, a bet amount and a horse, that provides the user with an opportunity to change selections for the new wager from at least one of the default selections to another selection, and that provides the user with an opportunity to place the new wager.

15 - 17. (withdrawn)

18. (previously presented) The system of claim 14, wherein the at least one default setting of the default wager is a previously selected track.

19 - 20. (withdrawn)

EVIDENCE APPENDIX B  
COPY OF THE FINAL OFFICE ACTION DATED OCTOBER 17, 2005



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,484	12/04/2005	Connie T. Marshall	ODS/018	5978

1473 7590 10/17/2005

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ROPES & GRAY LLP  
1251 AVENUE OF THE AMERICAS FL C3  
NEW YORK, NY 10020-1105

EXAMINER

NGUYEN, BINH AN DUC

ART UNIT PAPER NUMBER

3713

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.	Applicant(s)	
09/729,484	MARSHALL ET AL	
Examiner	Art Unit	
Binh-An D. Nguyen	3713	

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 5-7, 9-13, 15-17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 8, 14 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/2/05</u> | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The Amendment and the Information Disclosure Statement filed February 16, 2005 and March 2, 2005, respectively, have been received. According to the Amendment, claims 4-10 and 14-20 have been amended. Currently, claims 1-20 are pending in this application, wherein claims 1-3, 5-7, 9-13, 15-17, 19, and 20 have been previously withdrawn due to non-elected inventions. Claims 4, 8, 14, and 18 are hereby examined on the merits. Acknowledgment has been made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4, 8, 14, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Brenner et al. (6,004,211).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in



Art Unit: 3713

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Referring to claims 4 and 14, Brenner et al. teaches a system and method of providing a user interface for interactive wagering, comprising: a user input device (122)(Figure 1) that accepts user inputs (2:32-67; 8:15-28); and control circuitry (140)(Figure 2)(7:55-67) for providing a user with an opportunity to create a default wager as one of the user inputs (player starts the interactive racing game by selecting race tracks, races, wager types, and wager amount, 9:6-10:35, Fig.3), wherein the default wager includes at least one default setting (the setting that could be reused, i.e., "duplicate a wager" (12:45-50), that displays default selections for a new wager based on the default wager (i.e., the wager including selected race track, race, wager types, and wager amount that have already been selected by the player selection, (9:49-10:24)), wherein the new wager requires selection of at least a track, a race, a bet type, a bet amount and a horse (9:6-10:35), that provides the user with an opportunity to change selections for the new wager from at least one of the default selections to another selection (selecting "duplicate a wager" or "delete" wager, and that provides the user with an opportunity to place a new wager either by duplicated the created wager or creating another new wager (12:39-51)(Figs.8-19).

Referring to claims 8 and 18, Brenner et al. teaches the at least one default setting of the default wager is a previously selected track (using the hot button to bet on the next race and by pass selection steps 196, 204, and 213)(Figure 3 and column 17, lines 10-26, or using the "duplicate a wager" feature).

***Response to Arguments***

Applicant's arguments filed February 16, 2005 have been fully considered but they are not persuasive. The applicant argued that Brenner et al. does not teach the limitations<sup>of</sup> claims 4 and 14 (applicant's remark, page 12, lines 1-13) deemed not to be persuasive. Brenner et al. teaches an interactive wagering system that enables the player to create a default setting type of wager that could be reused such as duplicating a wager or delete undesired wager; and further, provides the user an opportunity to place a new wager either by duplicating the already created wager or creating another new wager. Please see column 12, lines 39-51. Thus, Brenner et al. fully anticipates the claimed limitations of claims 4 and 14.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wilson et al. (5,411,258) teaches an interactive video horse-race game comprising data storage and retrieval means for storing and retrieving racing and wagering information.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3713


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN

  
XUAN M. THAI  
SUPERVISORY PATENT EXAMINER  
TC3700

EVIDENCE APPENDIX C  
COPY OF BRENNER U.S. PATENT NO. 6,004,211